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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

GROUP 1700

Paper No. 14

Application Number: 09/163,778

Filing Date: September 30, 1998

Appellant(s): LEPINE, ALLAN

Susan M. Luna
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed January 23, 2001.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1 and 3-14 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4,614,653	Kakade	9-1986
5,709,888	Gil et al	1-1998
4,938,984	Traitler et al	6-1990
4,294,856	Kinumaki et al	11-1981
5,294,458	Fujimori	3-1994

Oftedal, O., "Lactation in the Dog: Milk Composition and Intake by Puppies" J. Nutr., 114:803-812.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3-14 rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 9.

(11) *Response to Argument*

For the above reasons, it is believed that the rejections should be sustained.

I. A PRIMA FACIE CASE OF OBVIOUSNESS HAS BEEN MADE TO RENDER CLAIMS 1 AND 3-14 OBVIOUS.

Claims 1 and 3-14 are obvious in view of the prior art. The appellant argues that the cited prior art is not combinable and is applied only in hindsight of the present invention. However, the prior art references are all directed to nutritional components for animals. The combinations of the references are proper. In light of the teachings of Oftedal, Kakade, Gil, Traitler, Kinumaki and Fujimori, the claimed invention would be obvious to one of ordinary skill in the art without the need for hindsight recognition of the instant invention.

The combinations of the references are proper. In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Oftedal, Kakade, Gil, Traitler, Kinumaki and Fujimori all provide a teaching, suggestion, or motivation to combine the teachings found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. For example, Oftedal teaches canine milk (Lactation in the Dog: Milk Composition and Intake by Puppies, abstract). Kakade teaches a milk replacer that is capable of meeting the shelf life requirements of a commercial product.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the milk taught by Oftedal to produce a commercial milk replacer.

One of ordinary skill at the time of the invention would not require the use of hindsight reasoning to recognize that the claimed invention is obvious. In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

II. THE REJECTION OF CLAIMS 1, 3-5 AND 9 BASED ON THE TEACHINGS OF OFTEDAL AND KAKADE IS PROPER.

The claimed invention is directed to a "canine milk substitute" and not a milk substitute for puppies. In response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., a milk substitute designed for puppies) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Although the appellant argues that an important aspect of the claimed invention is that the invention is a specially designed

milk substitute for puppies, the term puppies is not recited in the claims. For that matter, the term "canine " is only recited in the preamble of the claim. In fact, the age of the animals for which the milk substitute has been specifically designed for is not recited in the claims. The milk substitute of the claimed invention could be used for animals of any age. For example, it could be desirable to use the instant invention in the treatment of critical care animals.

The use of the product, whether it is for pigs, cats or other mammals, is merely an intended use. In response to appellant's argument that the product is designed for puppies, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The appellant argues that the claimed invention is designed specifically for puppies. In the instant case, the teaching of the milk compositions found in the prior art would be capable of performing the same intended use.

The cited prior art references are all directed to the improving the health and diet of animals. The claimed invention is a combination of known nutritional supplements for animals. As noted in the final Office action (paper number 9), these supplements aid in the development of animals. Thus, it would have been obvious to one of ordinary skill in

the art to apply the known nutritional supplements to a formula for animals such as puppies, dogs or any other pet or farm animal.

The appellant provides no evidence that the milk compositions cited in the prior art are distinct. Any evidence relied upon should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance."

Ex parte Gelles, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (Mere conclusions in appellants' brief that the claimed polymer had an unexpectedly increased impact strength "are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration."). The appellant is respectfully reminded that the Office does not have the facilities for examining and comparing Appellant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the appellant to prove that the claimed are functionally different than those taught by the prior art and to establish patentable differences. See *In re Best*, 562 F.2d 1252, 195 U.S.P.Q. 430 (CCPA 1977); *Ex parte Gray*, 10 U.S.P.Q.2d 1922, 1923 (BPAI).

Although the type of animal consuming or using a milk substitute is considered an intended use, claims 1, 3-5 and 9 would still be obvious in light of the teaching of Oftedal and Kakade. Oftedal teaches canine milk composition. Kakade is directed to monogastric animals. Canines fall clearly within this spectrum. The appellant argues that it appears that Kakade is directed only to farm animals. However, there is nothing in

the teaching of Kakade that limits the type of monogastric animals that may use the invention. The claimed invention is not distinguishable over the prior art.

The appellant argues that Oftedal in view of Kakade does not teach the precise ingredient ranges as noted in the claimed invention. Furthermore, the appellant argues that there is not motivation to combine Oftedal in view of Kakade. However, the combination of Oftedal in view of Kakade is proper.

The claimed ranges of the instant invention would be obvious in view of the cited teachings. The appellant argues that the cited prior art does not teach the claimed range of protein of "about 35 to 45%". In addition, the appellant argues the rejection does not recite the same ratio of casein and whey. The claimed range of casein to whey is "about 70:30". The appellant argues that one of ordinary skill in the art would neglect the teaching of the studies cited in Oftedal due to the age of those references. However, one of ordinary skill in the art would art look to those references. Although Oftedal does teach a different protein range, this protein range can be explained by accounting for factors such as the type of feed used by each study and by examining at what stage of the lactation period the milk was sampled. Furthermore, the protein levels can be due to different sampling and analytical procedures (Oftedal, page 807). In the event that Oftedal does not teach the claimed range, Kakade discloses a protein range of "about 13.3% to 32%" on a dry matter basis (Amended Brief on Appeal, pg. 10, paper number 13). It would have been obvious to one of ordinary skill in the art at the time of the invention that about 32% protein as taught by Kakade would read on about 35% as disclosed in the claimed invention.

It is also noted that Kakade teaches that the character of the protein is especially important for young animals to provide the necessary growth factors (U.S. Patent 4,614,653, col. 2, lines 50-55). In addition, Kakade teaches that the protein may be provided at a variety of levels (col. 4, lines 10-15). It would be expected that varying the levels of the protein and the character of the protein to optimize the needs of a young animal protein would effect the ratio of casein to whey. Thus, it would have been obvious to one of ordinary skill in the art to optimize the amount of protein and the ratio of casein to whey in the product of Oftedal as the character of the protein is a result effective variable that effects the necessary growth factors for a young animal.

The appellant further argues that the cited prior art does not teach the same claimed range of lactose. It would have been obvious to one of ordinary skill in the art at the time of the invention that about 10 to 35% lactose as taught by Kakade would read on about 8% lactose as disclosed in the claimed invention. Furthermore, it is noted that Kakade teaches that the level of the lactose may or may not be treated with lactase (col. 2, lines 20-35). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention that the level of the lactose may vary.

Finally, Appellants' attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the appellant asserts his right to a

patent. In all such cases, there is nothing patentable unless the appellant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

III. ONE SKILLED IN THE ART WOULD LOOK TO ANIMAL FORMULAS TO PRODUCE A MILK REPLACER.

One skilled in the art would look to animal formulas to produce a milk replacer. The appellant argues that one of ordinary skill in the art would not look to human infant formula to modify a milk replacer for puppies. However, a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the cited references are directed to compositions for consumption by animals. Gil and Traitler both teach that it is desirable to add fatty acids to animal food compositions. Furthermore, all of the milk compositions are directed for use in mammals. One of ordinary skill in the art would certainly look to the ingredients of other milk compositions to enhance the nutritional benefits of a milk composition. Furthermore, it would have been obvious to one of ordinary skill in the art to optimize the amount of an ingredient to enhance the nutritional benefit to the animal.

IV. THE REJECTIONS BASED ON KINUMAKI ET AL AND FUJIMORI ARE PROPER.

Kinumaki et al (Kinumaki) teaches a formula for infant animals. The appellant argues that one of ordinary skill in the art would not look to combine Kinumaki with the other references because Kinumaki is not specifically directed to canines. Although Kinumaki does not specifically disclose using the formula for feeding dogs, Kinumaki does teach that the formula can be used with other animals (U.S. patent 4,294,856, col. 1, lines 25-30).

Fujimori teaches that it is desirable to add fructooligosaccharide to a food composition as it aids in the digestion of the food product (U.S. Patent 5,294,459, col. 2, lines 40-55). Furthermore, as noted above, it is considered that one of ordinary skill in the art would look to other animal feed formulas to improve a formula composition. Thus, the rejections based on Kinumaki and Fujimori are proper.

V. ONE OF ORDINARY SKILL AT THE TIME OF THE INVENTION WOULD NOT REQUIRE THE USE OF HINDSIGHT REASONING TO RECOGNIZE THAT THE CLAIMED INVENTION IS OBVIOUS IN VIEW OF THE PRIOR ART.

One of ordinary skill in the art at the time of the invention would not need the benefit of hindsight reasoning to recognize that the claimed invention is obvious in view of the prior art. The appellant argues that the compositions of the cited prior art would not be effective in puppies. As noted above, the appellant fails to provide evidence of this assertion. In fact, the recitation of "canine" is only found in the preamble of the claim. In response to appellant's arguments, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for

completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

VI. THE DOUBLE PATENTING REJECTIONS IN VIEW OF U.S. PATENT 5,792,501 ARE PROPER.

Claims 1 and 3-14 are rejected under the doctrine of obviousness-type double patenting as being unpatentable U.S. Patent No. U.S. Patent 5,792,501 in view of the references cited above. The double patenting rejections are proper. Claims 1 and 3-14 are rejected under the doctrine of obviousness-type double patenting as being unpatentable U.S. Patent No. U.S. Patent 5,792,501 (501 patent) in view of the references cited above. The appellant argues that the claimed ranges of the 501 patent are not the same ranges as noted in the claimed invention of the instant application. However, the double patenting rejection is not a rejection based a statutory type (35 U.S.C. 101) double patenting rejection. Although the appellant concedes that the compositions claimed in U.S. Patent 5,792,501 are similar to the claimed invention of the instant invention, the appellant argues that a double patenting rejection is not warranted because the 714 patent is directed to felines an not canines. The appellant also argues that there is no motivation to combine the cited prior art. However, as noted above, the use of the product is considered an intended use and the motivation to combine the references is considered proper.

VII. The Double Patenting Rejections In View of U.S. Patent 5,882,714 Are Proper.

The double patenting rejections are proper. Claims 1 and 3-14 are rejected under the doctrine of obviousness-type double patenting as being unpatentable U.S. Patent No. U.S. Patent 5,882,714 (714 patent) in view of the references cited above. The appellant argues that the claimed ranges of the 714 patent are not the same ranges as noted in the claimed invention of the instant application. However, the double patenting rejection is not a rejection based a statutory type (35 U.S.C. 101) double patenting rejection. Although the appellant concedes that the composition claimed in U.S. Patent 5,882,714 are similar to the claimed invention of the instant application, the appellant argues that a double patenting rejection is not warranted because the 714 patent is directed to felines and not canines. The appellant also argues that there is no motivation to combine the cited prior art. However, as noted above, the use of the product is considered an intended use and the motivation to combine the references is considered proper.

VIII. CONCLUSION

Claims 1 and 3-14 are obvious in view of the prior art. The appellant argues that the cited prior art is not combinable and is applied only in hindsight of the present invention. However, the prior art references are all directed to nutritional components for animals. The combinations of the references are proper. Although the appellant wishes to distinguish the prior art from the claimed invention by asserting that the claimed

invention is a composition developed specifically for puppies. It is noted that the claims do not recite the limitation directed to puppies and the applicant fails to support this assertion with evidence. Furthermore, the use of the product whether it is for puppies or an other type of animal is an intended use. Finally, the cited prior art is combinable and proper. Thus, claims 1 and 3-14 are obvious in view of the prior art.

Respectfully submitted,



Philip DuBois

April 9, 2001

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SPB 1761